



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/390,937 | 09/07/1999 | IGOR V. KARPENKO | VISAP022/P10 | 7838 |
| 22434 | 7590 | 01/03/2005 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250 | | | DIXON, THOMAS A | |
| | | ART UNIT | | PAPER NUMBER |
| | | 3629 | | |

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/390,937 | KARPENKO, IGOR V. |
| Examiner | Art Unit | |
| Thomas A. Dixon | 3629 | M |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2-8,20,29 and 32 is/are pending in the application.
4a) Of the above claim(s) 1,9-19,21-28,30 and 31 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 2-8,20 and 32 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 18 November 2002 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

1. Applicant's arguments have been considered, but are moot in view of new rejections below.
2. A careful review of the claims has necessitated the new rejections below.

Claim Interpretation

3. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 20, including a smart utility meter, a processing center and a communication device are disclosed in Frew et al (4,803,632) as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Further, as per structure limitations in the method claims.

Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)
"As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims, the recited structural limitations therein must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 20, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Frew et al (4,803,632).

As per Claim 1.

Frew ('632) discloses receiving a utility reading from a smart utility meter, the utility reading being a measure of the usage of the utility by a customer, wherein the utility reading is received from a first remote location across a first transmission medium, see figure 1 (meter 18, receiving device (26) and (32);

determining an amount after receiving the utility reading, wherein the amount is determined using the received utility reading, see column 1, lines 41-42;

receiving information associated with the location of the smart meter, see column 4, lines 29-41;

transmitting the amount directly to a financial institution after determining the amount, the amount being transmitted to the financial institution across a second transmission medium, wherein the financial institution is arranged to effect a payment of the amount by the customer, see column 3, line 64 – column 4, line 5.

Frew ('632) does not specifically disclose the information is address information, address information is seen to be non-functional descriptive material, and further, is well known as taught by Moore (6,133,850), column 2, lines 61-67.

As per Claim 2.

Frew ('632) further discloses the first transmission is network communications, see figure 1 (32).

As per Claim 3.

Frew ('632) further discloses the second transmission is network communications, see figure 1 (32).

As per Claim 5.

Frew ('632) further discloses receiving a unit code, the unit code being arranged to identify the units associated with the utility reading, see column 1, line 31 and column 4, lines 29-41.

Art Unit: 3629

As per Claim 6.

Frew ('632) does not specifically disclose transmitting the amount to the financial institution across a second transmission medium includes transmitting the amount across a global telecommunications network, the global telecommunications network being arranged to perform clearance and settlement transactions type of network will be given no weight, and further, is well known as taught by Moore (6,133,850), figure 1 (110).

As per Claim 7.

Frew ('632) further discloses generating a credit message using the amount, wherein transmitting the amount to the financial institution includes transmitting the credit message to the financial location, see column 3, line 64 – column 4, line 5.

As per Claim 8.

Frew ('632) does not specifically disclose a debit, but the prepayment is seen to be equivalent, and further, equivalence between debit and credit is well known as taught by Kolling et al (5,920,847), figure 19 (B).

As per Claim 20.

Frew ('632) discloses a smart utility meter, a processing center and a communication device, see figure 1 (18, 68 and 62), further limitations are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

As per Claim 29.

Frew ('632) further discloses gas or water usage/cost, see column 1, lines 42-43.

As per Claim 32.

Frew ('632) further discloses gas or water usage/cost, see column 1, lines 42-43.

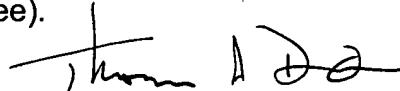
The limitations are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Examiner
Art Unit 3629

December 16, 2004